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Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/083,170
Filing Date: February 26, 2002
Appellant(s): FORMALE ET AL.

Mark D. Simpson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 06/23/08 appealing from the Office action

mailed 10/31/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Chapter Seven (Chapter 7 hereinafter, Disposition Sections 7.1,

http://www.stanford.edu/dept/U PA/chapter%207.html)

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC §101

1.   35 U.S.C. §101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

2.   Claims 2, 3, 6-10 are rejected under 35 U.S.C. §101 because the claimed

invention is directed to non-statutory subject matter.

3.   Based on Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184

(1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S.

63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal

Circuit decisions, §101 process must (1) be tied to another statutory class (such as a

particular apparatus) or (2) transform underlying subject matter (such as an article or

materials) to a different state or thing (the Supreme Court recognized that this test is not

necessarily fixed or permanent and may evolve with technological advances. *Gottschalk

v. Benson*, 409 U.S. 63, 71 (1972)).

4.   If neither of these requirements is met by the claim(s), the method is not a patent

eligible process under 35 U.S.C. §101.

5.   In this particular case, regarding the first test, in performing the steps of the

claimed subject matter, there is no requirement that a machine be used, thus the claims

are not considered sufficiently tied to another statutory class. Regarding the second

test, since the claimed subject matter may be performed using only human intelligence,

the steps do not sufficiently transform the underlying subject matter to be statutory.

Thus, to qualify as a 101 statutory method, the claim should positively recite the other

statutory class (the thing or product) to which it is tied and should sufficiently transform

the underlying subject matter.

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

7.   Claims 11-20 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention. The scope of a means plus function limitation

has to be defined by the structure disclosed in the specification plus any equivalent of

that structure. In the absence of structure disclosed in the specification to perform those

functions, the claim limitations would lack specificity. In the present situation, it appears

that the means for carrying out the functions recited in claims 11, 14 and 15 are directed

to a computer software/algorithm. However, the specification only mentions a central

server configured to perform the recited functions with no disclosed algorithm to perform

the function. The examiner contends that to claim a means for performing a particular

function and then to disclose only a general purpose computer as the structure

designed to perform the function in the absence of any algorithm amounts to pure

functional claiming. The examiner further contends that because general purpose

computers i.e., servers can be programmed/configured to perform very different tasks

in very different ways, simply disclosing a computer as the structure designated to

perform a particular function does not limit the scope of the claim to the corresponding

structure as required by section 112th, paragraph 6. Thus, in a means –plus-function

claim in which the disclosed structure is a computer, or microprocessor, programmed to

carry out an algorithm, the disclosed structure is not the general purpose computer, but

rather the special purpose computer programmed to perform the disclosed algorithm.

Claim Rejections - 35 USC § 102

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

        form the basis for the rejections under this section made in this Office action:

        A person shall be entitled to a patent unless –

        (b) the invention was patented or described in a printed publication in this or a foreign country or in public
        use or on sale in this country, more than one year prior to the date of application for patent in the United
        States.

9.   Claims 1-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Chapter

        Seven (Chapter 7 hereinafter, Disposition Sections 7.1,

        http://www.stanford.edu/dept/UPA/chapter%207.html).

Re claims 1, 2 and 3. Chapter 7 discloses a method of managing assets controlled by

members of an organization, said organization having a central server (i.e., CAMS, see

pg 2 under OVERVIEW) configured to access data and software systems of said

organization (on-line disposal request, see pg 5, line 16), comprising the steps of:

identifying one or more of said assets for management (i.e., identify items which are

excess, see pg 5 line 27) and submitting an asset disposition request to said central

server (i.e.,Click "route Disposal request" button to route….and select CAMS DR in

prism, see pg 7 lines 8-15. The examiner submits that disposal request are

routed/submitted to CAMS DR in prism where a DPA supervisor can retrieve the

disposal request form for approval); at the central server, automatically, based on

receipt of said asset disposition request, obtaining all required approvals for said asset

disposition request; (see pg 7 lines 21-42), at the central server automatically, based on

said obtaining of all required approvals, effecting said asset disposition request (i.e.,

PMO will proceed with processing the disposition request, see pg7 line 42); at the

central server and automatically modifying said data to reflect said effected disposition

request (i.e., update CAMS record with sales/scrap data per SPS disposal report, see

pg 12 #8, also see "proper CAMS record can be created, modified or disposed," see pg

5 line 11) (see pgs 1-19).

Re claim 4. Chapter 7 discloses a method wherein said data includes asset inventory

data, personnel data, and financial data, and wherein said software systems of said

organization include an automated routing system (i.e., prism routing system, see pg 2

under overview) coupled to said asset inventory data, said personnel data, and said

financial data, said step of automatically obtaining all required approvals comprising at

least the steps of: identifying from said asset inventory data all assets affected by said

asset disposition request (i.e., identify items which are excess, see pg 5 line 27);

determining from if said identified assets meet a predetermined disposition criteria (see

pg 5 lines 26-41, also see pg 9); if said predetermined disposition criteria has been met

(see pg 7 line 21), identifying from said personnel data any personnel required to

approve said asset disposition request (see pg 7 lines 21-25); requesting approvals

from said identified personnel using said automated routing system (see pg 7 lines 21-42); and receiving said approvals from said identified personnel using said automated routing system (see pg 7 lines 21-42).

Re claims 5, 6-10. Chapter 7 discloses a method wherein said step of automatically effecting said asset disposition request comprises at least the steps of: changing the control status of identified assets in accordance with said asset disposition request; notifying, using said automated routing system, any member of said organization responsible for effecting said disposition request; receiving, from said member(s) of said organization responsible for effecting said disposition request, confirmation that said asset disposition request has been effected; and notifying, using said automated routing system, all members of said organization affected by said disposition (see pg 7 lines 21-42, also see pg 5 lines 26-41) (see pgs 1-19).

Re claims 11, 12 and 13. Chapter 7 discloses a system for managing assets controlled by members of an organization, said organization having a central server configured to access data and software systems of said organization (on-line disposal request, see pg 5, line 16), comprising: means for identifying one or more of said assets for management (i.e., identify items which are excess, see pg 5 line 27) and submitting an asset disposition request to said central server (i.e., ., Click "route Disposal request" button to route....and select CAMS DR in prism, see pg 7 lines 8-15. The examiner submits that disposal request are routed/submitted to CAMS DR in prism where a DPA supervisor can retrieve the disposal request form for approval); means for automatically, at the central server, based on receipt of said asset disposition request, obtaining all

required approvals for said asset disposition request (see pg 7 lines 21-42); means for

automatically, at the central server, based on said obtaining of all required approvals,

effecting said asset disposition request (i.e., PMO will proceed with processing the

disposition request, see pg7 line 42); and means for automatically, at the central server,

modifying said data to reflect said effected disposition request (i.e., update CAMS

record with sales/scrap data per SPS disposal report, see pg 12 #8) (see pgs 1-19)

Re claim 14. Chapter 7 further discloses a system as set forth in claim 11, wherein said

data includes asset inventory data, personnel data, and financial data, and wherein said

software systems of said organization include an automated routing system (i.e., prism

routing system, see pg 2 under overview) coupled to said asset inventory data, said

personnel data, and said financial data, said means for automatically obtaining all

required approvals comprising at least: means for identifying from said asset inventory

data all assets affected by said asset disposition request (i.e., identify items which are

excess, see pg 5 line 27, also see pg 7 lines 21-42; means for determining if said

identified asset(s) meet a predetermined disposition criteria (see pg 5 lines 28-30);

means for identifying from said personnel data, if said predetermined disposition criteria

has been met (see pg 5 lines 26-41, also see pg 9), any personnel required to approve

said asset disposition request; means for requesting approvals from said identified

personnel using said automated routing system (see pg 7 lines 21-42); and means for

receiving said approvals from said identified personnel using said automated routing

system (see pg 7 lines 21-42).

Re claims 15, 16-20. Chapter 7 further discloses a system, wherein said means for

automatically effecting said asset disposition request comprises at least: means for changing the control status of identified assets in accordance with said asset disposition request; means for notifying any member of said organization responsible for effecting said disposition request; means for receiving, from said member(s) of said organization responsible for effecting said disposition request, confirmation that said asset disposition request has been effected; and means for notifying all members of said organization affected by said disposition (see pg 7 lines 21-42, also see pg 5 lines 26-41) (see pgs 1-19).

Re claims 21, 22 and 23. Chapter 7 further discloses a computer program product for managing assets controlled by members of an organization, said organization having a central server configured to access data and software systems of said organization, the computer program product comprising a computer-readable storage medium having computer-readable program code embodied in the medium, the computer-readable program code comprising: computer-readable program code that identifies one or more of said assets for management (i.e., identify items which are excess, see pg 5 line 27, also see pg 7 lines 21-42) and submits an asset disposition request to said central server (i.e., ., Click "route Disposal request" button to route....and select CAMS DR in prism, see pg 7 lines 8-15. The examiner submits that disposal request are routed/submitted to CAMS DR in prism where a DPA supervisor can retrieve the disposal request form for approval); computer-readable program code that automatically, based on receipt of said asset disposition request, obtains all required approvals for said asset disposition request (see pg 7 lines 21-42); computer-readable

program code that automatically, based on said obtaining of all required approvals (i.e.,

PMO will proceed with processing the disposition request, see pg7 line 42), effects said

asset disposition request; and computer-readable program code that automatically

modifies said data to reflect said effected disposition request (i.e., update CAMS record

with sales/scrap data per SPS disposal report, see pg 12 #8) (see pgs 1-19).

Re claim 24. Chapter 7 discloses a computer program product, wherein said data

includes asset inventory data, personnel data, and financial data, and wherein said

software systems of said organization include an automated routing system (i.e., prism

routing system, see pg 2 under overview) coupled to said asset inventory data, said

personnel data, and said financial data, and wherein the computer-readable program

code that automatically obtains all required approvals comprises at least: computer-

readable program code that identifies from said asset inventory data all assets affected

by said asset disposition request; computer-readable program code that determines if

said identified assets meet a predetermined disposition criteria; computer-readable

program code that (see pg 5 lines 26-41, also see pg 9), if said predetermined

disposition criteria has been met, identifies from said personnel data any personnel

required to approve said asset disposition request (see pg 7 lines 21-42); computer-

readable program code that requests approvals from said identified personnel using

said automated routing system; and computer-readable program code that receives

said approvals from said identified personnel using said automated routing system (see

pg 7 lines 26-41) (see pgs 1-19).

Re claim 25, 26-30. Chapter 7 further discloses a computer program product, wherein

the computer-readable program code that automatically effects said asset disposition

request comprises at least: computer-readable program code that changes the control

status of identified assets in accordance with said asset disposition request; computer-

readable program code that notifies, using said automated routing system, any member

of said organization responsible for effecting said disposition request; computer-

readable program code that receives, from said member(s) of said organization

responsible for effecting said disposition request, confirmation that said asset

disposition request has been effected; and computer-readable program code that

notifies, using said automated routing system, all members of said organization affected

by said disposition (see pg 7 lines 21-42, also see pg 5 lines 26-41) (see pgs 1-19).

(10) Response to Argument

In Response to the appellant's argument concerning the 35 U.S.C 102(b)

rejection of claims 1-30.

Appellant argues in substance that the prior art of record, Chapter 7, fails to disclose a

central server or any type of computer that will automatically carry out the process of

asset management i.e., automatically obtains all required approvals for asset disposition

request, automatically effects asset disposition request, and automatically modifies data

to reflect effected disposition request as in the claimed invention. Contrary to the

appellant's assertion, Chapter 7 discloses the procedure for processing on-line disposal

request. That is to say, Chapter 7 procedure for processing disposal request is fully

automated. Chapter 7 further teaches the use of new technology (Oracle Fixed Assets

i.e., CAMS - capital asset management system) and Prism routing system to process

on-line disposal requests (see page 2 under overview). The examiner contends that the

Capital Asset Management System – CAMS, as taught by Chapter 7, is clearly akin to

the central server claimed by the appellant and it carries out the process of asset

management - automatically obtains all required approvals for asset disposition request

(i.e., DPA defaults as first approver; your name will be on the "Originator" line and after

final review of the information for accuracy and completeness, you will type "Approve"

under "Action." Each DR must have DPA supervisor, or higher level second approval;

Secondary approvers approve or return DR in Forms Action or in EMS (Electronic Mail)

Each DR automatically routes to PMO for final approval (Note: If any approver

 (DPA Supervisor or PMO) returns DR, the DPA must create new DR in CAMS, (There

is a "Copy DR" function in CAMS that allows a rejected DR to be copied and the data

modified) Contact .your PSR if assistance is.needed. PMO reviews DR and approves or

returns (PMO may add remarks). Approved "Sale, prism action is complete etc, see pg

7 lines 21-32), automatically effects asset disposition request (i.e, if there are no

restrictions, PMO will proceed with processing the disposition request, see pg7 line 42),

and automatically modifies data to reflect effected disposition request (i.e., update

CAMS record with sales/scrap data per SPS disposal report, see pg 12 #8, also see

"proper CAMS record can be created, modified or disposed," see pg 5 line 11), as in

the claimed invention. What is a central server? A central server is nothing but a

computer dedicated to a certain purpose. In the present case, that purpose is asset

management. Again, Chapter 7 Capital Asset Management System is set up for

processing on-line disposal requests and is synonymous to the central server claimed

by the appellant.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)**

above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer

exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal**

as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the

primary examiner by filing a reply under 37 CFR 1.111 with or without amendment,

affidavit or other evidence. Any amendment, affidavit or other evidence must be

relevant to the new grounds of rejection. A request that complies with 37 CFR

41.39(b)(1) will be entered and considered. Any request that prosecution be reopened

will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply

brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of

rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the

other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR

41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be

treated as a request that prosecution be reopened before the primary examiner under

37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO

MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to

reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex

parte reexamination proceedings.

Respectfully submitted,

/OJO O OYEBISI/

Examiner, Art Unit 3696

/THOMAS A DIXON/

Supervisory Patent Examiner, Art Unit 3696

Vincent Millin /VM/

Appeals Practice Specialist

A Technology Center Director or designee must personally approve the

new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn W. Coggins/

Director, TC 3600

Conferees:

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